

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD I. SUN et al.

Application 09/531,978

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on August 12, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

The Appeal Brief filed March 8, 2005 states on page 1 under the heading "Status of Claims" that "[c]laims 56-69, 76-87 are presently pending in the Application" and that "[c]laims 1-55 and 70-75 have been canceled as drawn to non-elected inventions." Page 2 states:

Appellants note for the record that the Examiner included claims 70-75 in the rejections contained in the first Office Action of this RCE on July 16, 2004 and the second Office Action of October 12, 2004, and Appellants' responses of July 29, 2004 and August 17, 2004 included reference to claims 70-75. However, claims 70-75 were not, and are not pending in this application since claims 70-75, along with claims 1-55, were cancelled in the amendment filed June 14, 2002 as directed to non-elected inventions. Accordingly, claims 70-75 are not subject to the present invention even though listed in the final rejection by the Examiner and included in the Notice of Appeal filed on January 12, 2005.

The Examiner's Answer mailed May 11, 2005 notes that "[t]he statement of the status of the claims contained in the Brief is correct [page 2]." However, the Examiner includes claims 70-75 in the first ground of rejection appearing on page 2 of the Answer. Clarification regarding the status of claims 70-75 is required. Also, the Examiner's Answer is not in compliance with the new rules regarding 37 CFR § 41.37(c) effective September 13, 2004.

In addition, we were unable to find a copy of the JP Kokai 59-49971 translation relied on by the examiner on pages 3 through 5 of the Examiner's Answer mailed May 11, 2005.

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Accordingly, it is

ORDERED that the application is returned to the
Examiner:

1) to locate and scan a complete copy of the English translation for JP Kokai 59/49971 into the Image File Wrapper (IFW) and supply a copy to the appellants;

2) for a determination regarding the status of claims 70-75;

3) to vacate the Examiner's Answer mailed May 4, 2005 and provide a revised Examiner's Answer in accordance with the new rules effective September 13, 2004;

4) for written notification to appellants regarding the action taken; and

5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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CRF/psb

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